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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,874	11/08/2001	Toshiya Nakamura	Hohjoh Case 46A	6044

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EXAMINER

TRINH, MINH N

ART UNIT	PAPER NUMBER
3729	5

DATE MAILED: 09/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/008,874	Applicant(s) NAKAMURA, TOSHIYA
Examiner	Art Unit Minh Trinh	3729

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 08 November 2001 .

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 7-10 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 7-10 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some \* c)  None of:

1.  Certified copies of the priority documents have been received.

2.  Certified copies of the priority documents have been received in Application No. 09/536,547.

3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1)  Notice of References Cited (PTO-892) 4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_ .  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948) 5)  Notice of Informal Patent Application (PTO-152)  
3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ . 6)  Other: \_\_\_\_\_ .

## **DETAILED ACTION**

### ***Title***

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The following title is suggested: "Method for Manufacturing Multi layer Ceramic Components".

### ***Specification***

2. The specification is objected to because the related application has already matured into a patent, therefore after "filed March 28, 2000" (in the specification, page 1, line 2) should be added: --, now Patent 6,349,026, issued February 19, 2002--.

3. The abstract of the disclosure is objected to because the scope of it is a product, which does not describe sufficiently the claimed method invention, and should be limited within the range of 50 to 150 words. Appropriate correction required. See MPEP § 608.01(b).

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

5. Claims 7-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following are examples;

The scope of claim 7-10 is directed to a method and the claims contain limitation such as "the multiplayer ceramic electronic part comprising . . ." as recited in the claim 7, lines 2-14 is directed to a product. Therefore it is not clear whether applicant intention to claim the method (see claim 7, line 1 and lines 16-28) or if applicant is intended to claim the product (as discussed in claim 7, lines 2-15). In formulating the examiner considers that claims is directed to a method of manufacturing a multiplayer ceramic electronic part and the claims will be examination accordingly.

It is not clear as to what being referred to "completing the multiplayer electronic part". Because there are many factors that are associated in "completing of the product" therefore it is not known as to what exactly happened in the "completing the multiplayer electronic part " of claim 7, lines 27-28. Applicant needs to be more specific.

It is not clear what applicant is referring as "pillar like ceramic portions" (see claim 7, line 11).

The phrase: "a pillar like" (claim 8, line 2) is indefinite because the metes and bounds of the claims can not be determined because it does not clearly set forth the metes and bounds of the patent protection.

The term: "it" (claim 9, line 5) is not clear as to exactly what applicant is referring to as "it"? Also, "up to an outer surface thereof" (claim 9, line 6) should be: --extend to an outer surface of the external electrodes--. For clarification of the claimed subject matter.

Art Unit: 3729

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 7 and 10, as best understood are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al (US 6,331932).

Kobayashi et al disclose a method for making ceramic body comprising preparing an unbaked laminated body comprising a ceramic layer 2 and internal electrodes 5a-5f being laminated on one another; forming external electrodes 6-7 (col. 2, lines 59-60) in contact with the internal electrodes at end surfaces of the laminated body (see col. 1, lines 30-36); baking the laminated body; and completing the multi layer ceramic electronic part (see col. 1, lines 55-65, noting that the sintering as described in the reference represented the baking step as required by the applicant invention).

Kobayashi et al inherently teach the step of applying and drying a conductor paste, into which is added a material common with a ceramic forming the ceramic layer of the laminated body, on edge portions of the unbaked laminated body (see col. 1, lines 26-29).

As applied to claim 10, Kobayashi et al teach that the forming the conductive film is selected from the group consisting of Ni, Cu, Pd and an Ag -Pd alloy (see col. 2, lines 48-51).

Further, regarding the recitation in the preamble, lines 2-16. i.e., the limitation recites "and a pillar like ceramic portions which are continuous in the direction of

thickness, " has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

### ***Allowable Subject Matter***

8. Claims 8-9 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The prior art do not teach or suggest the providing pillar like ceramic portions which are scattered on the conductor film for forming the external electrodes as recited in claim 8, lines 1-5, and the forming ceramic portions of the external electrodes, as recited in claim 9, lines 2-6. These limitations taken alone or in combination with other limitations is not taught by the prior art reference.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 3729

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Trinh whose telephone number is (703) 305-2887.

The examiner can normally be reached on Monday -Thursday 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (703) 308-1789. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.



Examiner, AU 3729

9/11/03, mt